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09/888,696	06/25/2001	Steve Alister Nixon	ACO 2799 US	1033

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07/15/2004

David H. Vickrey
Akzo Nobel Inc.
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/888,696
Filing Date: June 25, 2001
Appellant(s): NIXON, STEVE ALISTER

Richard Fennelly
For Appellant

MAILED
JUL 14 2004
GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 3, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1 to 4 and 9 to 18 stand or fall, as stated by appellants in the brief.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,902,851

Yamaki et al.

5/1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 to 4 and 9 to 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaki et al.

Since appellants admit that claims 1 to 4 and 9 to 18 stand or fall together, this rejection will only address the limitations of independent claim 1.

Yamaki et al. teach a coating composition that contains an acrylic polymer having alkoxysilyl functional groups (see column 4, lines 40 to 57) and a linear polysiloxane diol (see column 4, line 62). Column 8 further teaches the acrylic polymer having alkoxysilyl functional groups. The bottom of column 10 further teaches the polysiloxane. Note that the preferred lower limits of 10 and 20 for "n" will result in a polysiloxane that meets the claimed molecular weight requirement (since each "n" unit has a molecular weight of 75). Also note component C-1 on column 20 that meets the molecular weight requirement for the polysiloxane in claim 1. In this manner both of the claimed components in claim 1 are anticipated by the prior art. Yamaki et al. fail to teach that the composition has more than 70% by weight solids. For the reasons that follow, the Examiner is of the position that such a composition would have been obvious to one having ordinary skill in the art.

First note that the Summary of the Invention and claim 1, which define the prior art composition, do not require *any* solvent for the composition. The Examiner acknowledges that component (A) is a silica dispersed oligomer solution which will inherently contain a solvent but this amount of solvent as found on column 7, lines 15 to 25, combined with the amount of (A) in the final composition as found on column 12, lines 45 to 65, is not sufficient to result in a final composition that is outside the claimed weight solids range. Note that column 13, lines 32 to 35, teaches that the composition can *optionally* be diluted with various organic solvents. Note too that columns 8 and 9 do not indicate that the acrylic resin must be used in a solvent system and column 10 does not indicate that the polysiloxane must be used in a solvent system. Patentees specifically teach that component (A) is used in a solvent system. The fact that (B) and (C) are not specifically taught to be used in a solvent system indicates that this is optional. Since patentees do not require any solvent in the composition (again with the exception of that which will be in component (A), an amount that is not enough to result in a composition having less than 70% by weight solids) one having ordinary skill in the art would have found this limitation to have been obvious over the teachings of Yamaki et al.

On the other hand, note column 13, lines 50 to 52. This states that, when a solvent is present, the ratio to be diluted may be suitably determined. This indicates that it is within the skill of the ordinary artisan to adjust the amount of solvent, and thus adjust the solids content, of the composition. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Furthermore, in view of the desirability of eliminating or reducing potentially hazardous or unfriendly solvents, the skilled artisan would have been motivated to decrease the amount of solvent in the composition. In this manner too one having ordinary skill in the art would have found a composition that falls within the claimed solids content to have been obvious and within routine experimentation and/or optimization of the teachings of Yamaki et al.

For these reasons one having ordinary skill in the art would have found a composition having a solids content within the claimed range to have been obvious over the teachings of Yamaki et al.

(11) Response to Argument

Initially the Examiner would like to note that appellants do not traverse the Examiner's position that the polysiloxane and acrylic polymer required by the claims are met by the teachings of Yamaki et al. Also appellants do not traverse the Examiner's position that the amount of solvent in the silica dispersed component (A) is not enough to result in a final solids content outside the claimed range.

Appellants' sole argument of this rejection rationale is that Yamaki et al. do not teach or suggest *how* to make a composition with a high solids content (see the second full paragraph of page 3 of the brief). They note that Yamaki et al. use solvents in the process steps and do not disclose any means for removing them or otherwise increasing the solids content. Again the Examiner notes that patentees specifically teach that component (A) is used in a solvent. The fact that no other components are specifically used in a solvent system clearly indicates that no other solvents are required. Surely one having ordinary skill in the art would have had the skill to remove any solvent that is

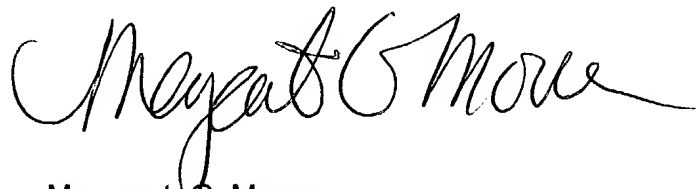
not necessary to the composition in Yamaki et al. Patentees are not limited by their working examples.

Appellants state that Yamaki et al. neither teach nor suggest any means for achieving a high solids content (brief page 5, second paragraph) but, again, patentees do teach that the ratio to be diluted may be suitably determined, indicating that it is within the skill of the ordinary artisan to determine the operable solids content.

With regards to the polymerization methods referred to on column 9, lines 40 to 45, patentees do not limit the preparation method to such methods and do not specifically state that the method of preparing must be limited to methods involving a solvent. Thus, with regards to appellants' position that Yamaki et al. do not enable a composition having a high solids content, it is the Examiner's position that the skilled artisan would have the knowledge of how to reduce or eliminate any solvent that may have been present from any preparation method. Specific teachings on how to separate an acrylic resin from a solvent, for instance, are not necessary. As such appellants' arguments are not persuasive.


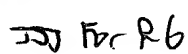
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in cursive script that reads "Margaret G. Moore".

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
July 11, 2004

Conferees
Jim Seidleck 
Randy Gulakowski 

David H. Vickrey
Akzo Nobel Inc.
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408